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APPLICATION NUMBER 087588-777 FILING DATE 12/07/95 FIRST NAMED APPLICANT SMITH R ATTY-DOCKET NO. 22189

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EXAMINER

DARBE, V

ART UNIT PAPER NUMBER

2305

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09/11/97

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 6-23-97

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims:

- ☒ Claim(s) 1-29 is/are pending in the application.  
Of the above, claim(s) is/are withdrawn from consideration.  
☐ Claim(s) is/are allowed.  
☒ Claim(s) 1-29 is/are rejected.  
☐ Claim(s) is/are objected to.  
☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number)  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received:

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892  
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s).  
☒ Interview Summary, PTO-413  
☒ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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***Response to Amendment***

1. Claims 1-29 remain for examination.
2. This action is responsive to applicants' amendment filed June 23, 1997.
3. Applicant's arguments filed June 23 have been fully considered but they are not persuasive. The rejection of claims 1-11, 13-29 as given in the previous office action are maintained as follows. Claim 12 has been amended and thus applicant's arguments with respect to claim 12 has been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more

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than one year prior to the date of application for patent in the United States.

5. As stated in the previous office action, claims 1-7,13, 15-17 and 19-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hop, U.S. Patent No. 4,912,756.

6. Regarding claims 1,7,13 and 29; Hop discloses a system using a personal computer to effectuate reliable data transmission over a cellular telephone system as illustrated in Figure 1. Element 19 is referred to as the mobile unit and is comprised of a portable PC (element 2), interface circuit (element 3, cellular connector (element 28) and CSE (Cellular subscriber equipment). Regarding claim 12; Hop shows a modem explicitly as element 24 in Figure 2.

7. Regarding claims 2,3,4,5,6; in the information processing and data communications arts, a computer inherently contains a data processor, memory or data and programs such as an operating system, input means (commonly a keyboard) and output means such as a display (LCD, monitor etc.). Hop does not explicitly show these features (except for the display in figure 2), nevertheless the features are inherent in Hop's disclosure.

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8. Regarding claims 15-17,19-28; these claims refer to the leads or lines between the interface and the microprocessor. The claims refer to voice channel leads, command channel leads, and a ground lead. Claim 16,17 and 20 also refer to the facilitation of a bidirectional half duplex mode. Claims 23,25 and 27 also refer the facilitation of a unidirectional full duplex mode. Hop discloses the connection of the interface to the computer via the COM1 port in figure 2. COM1 is discloses as a conventional RS232 to which a bidirectional serial bus is connected (col. 4, line 36-39). The RS232(-C) industry standard calls for a 25 pin connector including 2 data/voice lines and a variety of control (command) lines which facilitate either bidirectional half-duplex mode or unidirectional full-duplex mode.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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10. As stated in the previous office action; claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hop.

11. Claims 8,9,10,11 refer the positioning and securing of the portable telephone to a "cavity". Hop does not refer to a cavity or receptacle for the portable telephone in his disclosure, however Hop discloses, directly and indirectly, mobility and portability in his system. For example, he refers to "mobile unit" throughout his specification. The choice of how the portable telephone housing and computer/interface housing fit together is dependent upon a number of factors such as ease of use or access to telephone independently of the computer, intended dimension (e.g. to fit inside a standard sized briefcase, in an airplanes overhead bin, etc.) and the particular configuration of the components is a matter of which factor(s) are more important to the intended end-user.

12. As stated in the previous office action; claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hop in view of Dent et al., U.S. Pat. No. 5,581,597. Claim 18 refers the interface as having a power lead. Hop does not disclose such a power lead however Dent discloses in col. 8, lines 52-57 the

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use of a cellular terminal (such as a cellular telephone) plugged into a personal computer. While the cellular terminal is "parked" (i.e. plugged in), it may be powered from a power supply through leads as shown in figure 3. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide power to the cellular telephone while in use to transmit or receive data for the computer to prevent depleting the cellular telephone's battery unnecessarily. Failure of the battery without an alternate power supply would cause interruption of the data transmission and reception via the cellular telephone.

13. Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hop in view of Morris, U.S. Patent No. 5,020,090.

14. Claim 12 refers to the modem as being internal to the computer; Hop discloses a modem (element 24) in combination with the Portable PC in fig. 2 but does not specifically indicate that the modem is internal to the computer. Morris shows a portable computer which connects via a track mechanism in fig. 1. The abstract refers to the "modem in the computer" and the Morris' claims 1 and 8 refer to a "computer having...a modem". In the

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portable computer art, size is a critical factor in order to render the computer "portable"; it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the modem in the computer to reduce the size of the system.

15. Claim 14 refers to transmitting voice and data signals while the telephone and computer are connected. As stated above, Hop discloses COM1 as a conventional RS232 to which a bidirectional serial bus is connected (col. 4, line 36-39). The RS232(-C) industry standard calls for a 25 pin connector including 2 data/voice lines and a variety of control (command) lines which facilitate either bidirectional half-duplex mode or unidirectional full-duplex mode. The purpose of Hop is to provide data communications between two computer systems via a cellular telephone system.

16. Regarding the arguments pertaining to claims 1 and 29 that the interface is "directly connectable"; the term "interface" is extremely broad and can be interpreted as a wide variety of devices and components including a combination of circuits, cables etc.

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17. Regarding the arguments pertaining to claims 3, 4, 5, 6 and elements display, keyboard, memory and core logic; applicant himself cites case law (Page 2 line 2) refer to prior art having elements "inherently described". As stated above and in the previous office action; "in the information processing and data communications arts, a computer inherently contains a data processor, memory or data and programs such as an operating system, input means (commonly a keyboard) and output means such as a display (LCD, monitor etc.). Hop does not explicitly show these features (except for the display in figure 2), nevertheless the features are inherent in Hop's disclosure".

18. Regarding the argument pertaining to claim 7; Hop repeatedly refers to his computer as being a "portable PC", e.g. Col. 1, line 66.

19. Regarding the arguments pertaining to claims 13-28 pertaining to the leads (voice channel, ground, etc.), the modes (unidirectional full duplex, bidirectional half duplex), and voice and data communications; as stated above Hop discloses COM1 as a conventional RS232 to which a bidirectional serial bus is connected (col. 4, line 36-39). The RS232(-C) industry



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standard (**by definition**) calls for a 25 pin connector including 2 data/voice lines and a variety of control (command) lines which facilitate either bidirectional half-duplex mode or unidirectional full-duplex mode. The purpose of Hop is to provide data communications between two computer systems via a cellular telephone system.

20. Regarding the argument pertaining to claims 8-11 and the location of the portable telephone; in the portable telephone and portable computer arts: Portable (**by definition**) refers to concept of the item being carried, hence size, weight and dimensions are *critical* factors inherent in the design of **portable** telephones and computers and would necessarily be considered by one of ordinary skill in the art. Placing the telephone in a "cavity" of the computer would be desirable to minimize size and dimensions.

21. In addition, applicants are encouraged to review Morris in detail because the teachings of Morris are extremely relevant to details in the applicants specification.

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22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valerie Darbe whose telephone number is (703) 305-9839.

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24. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 8:30 am to 6:00 pm.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Jack Harvey can be reached on (703) 305-9705. The fax phone number for this Group is (703) 308-9051.

26. Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**jack.harvey@uspto.gov**].

27. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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28. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-<sup>3900</sup>~~9600~~.

*Gopal C. Ray*  
GOPAL C. RAY  
PRIMARY EXAMINER  
GROUP 2300

VAD  
September 5, 1997